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**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/921,533	09/02/97	TORMALA	2008/27

KENYON & KENYON
1025 CONNECTICUT AVENUE NW
SUITE 600
WASHINGTON DC 20036

HM42/1207

EXAMINER
CHANNARAJJALA, L

ART UNIT	PAPER NUMBER
1010	

DATE MAILED: 12/07/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/921,533

Applicant(s)
Tormala et al

Examiner
Lakshmi Channavajjala

Group Art Unit
1615



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1 and 2 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 and 2 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Receipt of Response to notice of file missing parts of application dated 2-23-98 is acknowledged.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 2 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 4,968,317 OR claims 1-7 of US Patent No. 5,084,051. Although the conflicting claims are not identical, they are not patentably distinct from each other because both patents '317 or '051 teach surgical composite materials made of resorbable polymeric matrix and reinforcing elements similar to that of the invention.

3. Claims 1-2 directed to an invention not patentably distinct from claims 1-8 of commonly assigned US patent No. 4968317 or claims 1-7 of US Patent No. 5,084,051. Specifically, patents '317 or '051 teach surgical composite materials made of resorbable polymeric matrix and reinforcing elements similar to that of the invention.

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4. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 4968317 ('317) to Tormala et al or US patent 5084051 ('051) to Tormala et al

'317 teaches a surgical material of resorbable polymer comprising a matrix phase which binds to a reinforcing elements. The resorbable polymer is partially fibrillated. The resorbable and the ceramic reinforcing materials of the instant invention are disclosed (entire patent, particularly abstract, cols. 2-8 and fig. 2). The material has higher strength and elastic modulus than those of the known implant materials and can be used for osteosynthesis.

'051 teaches a biocomposite material for bone surgical applications containing a biceramic component and a material component of reinforcing elements made up of resorbable polymer. The reinforcing elements are fibrillated and bound to the biceramic by application of heat and pressure so as to compensate for the brittleness of the bioceramics (see entire patent, especially cols 1-15). Therefore, the instant invention would have been obvious for a skilled artisan from the teachings of '317 or '051.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is (703) 308-2438. The examiner can normally be reached Monday through Friday from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax number for this Group is

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(703) 305-3592.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. § 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [thurman.page@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of confidentiality requirements of U.S.C. § 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703-308-1235).



Lakshmi S. Channavajjala

12/01/98



THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
ART UNIT 152-1615